

9p 1646

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: ASSISTANT COMMISSIONER FOR PATENTS, WASHINGTON, D.C. 20231 on the date shown below.



Date: Jan 8, 2001

By:

Lois E. Miller

PATENT/DX0903K

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

J. Fernando BAZAN

Serial No.: 09/399,492

Filed: September 20, 1999

For: MAMMALIAN CYTOKINES
RELATED REAGENTS AND
METHODS

Examiner: O. Chernyshev

Art Unit: 1646

**RESPONSE TO RESTRICTION
REQUIREMENT**

Palo Alto, California 94304

January 8, 2001

#12
MQJ
1/18/01

5 Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

10 This is a response to the Restriction Requirement (paper number 11), dated
December 13, 2000.

I. Restriction Requirement

15 The Examiner restricted the application into seven separate inventions:

- I. Claims 1 - 7, 9 - 10, drawn to polynucleotides, vectors, host cells and methods of making a polypeptide, classified in class 435, subclass 69.1, for example.
- 20 II. Claim 8, drawn to a method of forming a duplex, classified in class 435, subclass 504, for example.
- III. Claims 11 - 12, 15, drawn to binding compounds, classified in class 530, subclass 387.1, for example.
- IV. Claims 13 - 14, drawn to methods of using the binding compound, classified in class 436, subclass 501, for example.

25



Claims 16 - 18, drawn to a polypeptide, classified in class 530, subclass 350, for example.

Claims 19 - 20, drawn to a method of modulating physiology of a cell, involving agonist of a primate IL-B50, classified in class 435, subclass 375, for example.

VI. Claims 19 - 20, drawn to a method of modulating physiology of a cell, involving antagonist of a primate IL-B50, classified in class 435, subclass 375, for example.

Applicants provisionally elect Group I, Claims 1-7 and 9-10 whose claims are drawn to polynucleotides, vectors, host cells and methods of making a polypeptide, as discussed in the Office Action. Applicants traverse the Restriction Requirement on the grounds that a search for the novelty of the polynucleotides encoding an IL-B50 polypeptide, etc. of Group I would yield information regarding the novelty of a method of forming a duplex using these polynucleotides, the IL-B50 polypeptides, binding compounds raised against these polypeptides, and methods of using these binding compounds, encompassed by Groups I-V. Therefore examination of Groups I-V together would not be a serious burden on the examiner. Therefore, Applicants request the claims encompassed by Groups I-V, Claims 1-18 be rejoined and examined together. In particular, Applicants point out that if the polynucleotides of Group I are found allowable, then the method of using these polynucleotides as encompassed by Group II, Claim 8, should also be allowable. In view of the above, Applicants respectfully request reconsideration and/or withdrawal of the Restriction Requirement.

Applicants will address the issue of inventorship for the elected claims and amend inventorship appropriately if the elected restriction is made final.

Applicants reserve the right to file subsequent applications claiming the non-elected subject matter and do not waive any of their rights or abandon any non-elected subject matter. Since Applicants have fully and completely responded to the Restriction Requirement and have made the required election, this application is now in order for early action.

If the Examiner believes that a telephone conference would aid the prosecution of this case in any way, please call the undersigned



Respectfully submitted,

Date: January 8, 2001

By:

Sheela Mohan-Peterson
Sheela Mohan-Peterson
Attorney for Applicants
Reg. No. 41,201

DNAX Research Institute
901 California Avenue
Palo Alto, California 94304-1104
Main: (650) 852-9196
Direct: (650) 496-1244
Fax: (650) 496-1200